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EXAMINER	
LEGUYADER, J.	
ART UNIT	**PAPER NUMBER**
1635	5

DATE MAILED: 03/25/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), X days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. ☐ Notice of References Cited by Examiner, PTO-892.
2. ☒ Notice of Draftsman's Patent Drawing Review, PTO-948.
3. ☒ Notice of Art Cited by Applicant, PTO-1449.
4. ☐ Notice of Informal Patent Application, PTO-152.
5. ☐ Information on How to Effect Drawing Changes, PTO-1474.
6. ☐ _____.

Part II SUMMARY OF ACTION

1. ☒ Claims 1-43 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-6, 17, 18 + 26-28 are rejected.

5. ☒ Claims 7-16, 19-25 + 29-43 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☒ been filed in parent application, serial no. 07/945,411; filed on 9/9/92.

13. ☐ Since this application apppears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

The instant application fails to comply with the Rules concerning the disclosure of nucleotide sequences as per 37 CFR 1.821-1.825. No paper or computer listing has been submitted, nor has a request been filed seeking to have the Office prepare a computer listing from parent application 07/965,411. Sequence identifiers have not been assigning to the nucleotide sequences set forth in the instant application. A complete response to the instant Official action must correct the noted deficiencies concerning the sequence Rules as part of a complete response to this Official action.

Claims 7-16, 19-25 and 29-43 are objected to under 37 CFR 1.75© as being in improper form because a multiple dependent claim can not be dependent on other multiple dependent claims. For example, claim 7 is dependent on claim 3 which is dependent on claims 1 or 2. Furthermore, claims 7, 11 and 21 fail to reference any particular preceding claim. See MPEP § 608.01(n). Accordingly, the claims 7-16, 19-25, and 29-43 have not been further treated on the merits.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 17 and 18 are rejected under 35 U.S.C. 101 as claiming the same invention as that

of claims 25-26 of prior U.S. Patent No. 5,672,695. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-6 and 17-18 are rejected under the judicially created doctrine of double patenting over claims 1-26 of U. S. Patent No. 5,672,695 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Patent '695 and the instant application claim the same ribozymes. The ribozymes of the instant application embrace additional species, where the scope claimed here embrace the ribozymes claimed in '695.

Note that although claims 17 and 18 were rejected above under 101 double patenting over claims 25 and 26 of '695, they are also included here since the scope of the claimed RNA in instant claims 25 and 26 is ambiguous. See the section 112, second paragraph rejection set forth below.

Furthermore, there is no apparent reason why applicant was prevented from presenting

claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 2-6, 17, 18, and 26-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-6, 17, 18, and 26-28 fail to recite a definite article as the first word of the preamble. The scope of the claimed subject matter in the claims is ambiguous in view of the foregoing. For example, the recitation of "RNA" or "Process" as the first word of the preamble of the claims is ambiguous in terms of scope since it is not clear if applicants intend an RNA or a process or multiple RNAs or processes. In U.S. patent practice independent claims more typically recite "A" or "An" to clearly set forth a claimed composition or process, where dependent claims refer back to independent claims using the definite article "The".

Any inquiry concerning this communication should be directed to John L. LeGUYADER at telephone number (703) 308-0447. Please note that the examiner's compressed workweek day off is every Friday.

JOHN L. LeGUYADER
PRIMARY EXAMINER
GROUP ~~1800~~ 1600

John L. LeGUYADER
March 25, 1998